

In addition, the Examiner is requiring the election of a single ultimate disclosed specie for each of the following:

- (i) Surface treatment;
- (ii) Filler; and
- (iii) Binder.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the relationship between Groups I and II as mutually exclusive species in an intermediate-final product relationship. Citing MPEP §806.04(h) and MPEP §806.04(b), third paragraph, the Office suggests that the "intermediate product is deemed to be useful in a catalyst composition, and the inventions are deemed patentably distinct". However, there is no evidence of record to show that the claimed products are useful as the Office has alleged. The Office has merely stated a conclusion that the claimed products are useful in "catalyst composition". Furthermore, the Office has not shown that "catalyst composition" and the inventions of Groups I and II are materially different.

Accordingly, Applicants respectfully submit that the Requirement for Restriction is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups I or II and III as related as product and process of use. Citing MPEP §806.05(h), the Office concludes that the "product as claimed would have materially different uses such as a catalyst composition." The Office has merely stated a conclusion and failed to show that its alleged use of as "a catalyst composition" is materially different from what is claimed. Accordingly, Applicants

respectfully submit that the Requirement for Restriction is unsustainable, and it should therefore be withdrawn.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application. Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

With respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Finally, Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Therefore, for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction and Election of Species. Withdrawal of the Requirement for Restriction and Election of Species is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Rohitha M. Jayasuriya
Registration No. 50,385



22850

PHONE: (703) 413-3000
FAX: (703) 413-2220
NFO:RMJ: